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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,550	01/03/2001	Pauli Kytönen	3397-93PUS	3362

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EXAMINER

HALPERN, MARK

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 04/05/2002

Please find below and or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/720,550

Applicant(s)

KYTONEN ET AL

Examiner

Mark Halpern

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. 37 U.S.C. § 133.
- Any reply received by the Office later than three months after the mailing date of this communication (even if timely filed) may, at the discretion of the examiner, be subject to patent term adjustment. See 37 CFR 1.134(c).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL** 2b) ☐ This action is non-final
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) to a provisional application.
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-348)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s): 2
- 4) ☐ Interview Summary (PTO-413) Paper No(s): _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other _____

DETAILED ACTION

- 1) Acknowledgement is made of preliminary Amendment received 1/3/2001. Paper No. 5. Applicants cancel claims 1-13, and offer new claims 14-34, for consideration.

Specification

- 2) This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 3) Claims 14-34, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 14 recites the limitation "the surfaces" in line 3; the limitation "the calendered surface" in line 5; the limitation "the base web" in line 5; the limitation "the coated surface" in line 7; the limitation "the base web" in line 7. There are insufficient antecedent bases for these limitations in the claim.

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Claim 15 recites the limitation "the uncoated surface" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "the web" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 21-22, line 2: should the term "in" be replace with "is".

Claims 25-26: improper Markush language is used.

Claim 27 recites the limitation "the surfaces" in line 3; the limitation "the calendered surface" in line 5; the limitation "the base web" in line 6; the limitation "the coated surface" in line 7. There are insufficient antecedent bases for these limitations in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claims 14-15, 18-22, 27-28, 31-32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Eriksson (WO 96/28609) in view of Van Haag (5,582,689).

Claims 14-15, 27-28: Eriksson discloses a process of making coated paper board, where the board is first calendered, followed by said board being coated by a coating device and then calendered in a heated calender (Eriksson, pg. 5, lines 8-18). The calendars have a nip of length from 3 to 10 cm (Eriksson, pg. 3, lines 24-25).

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Additionally, the claim recites limitation that the calendaring before coating to be performed with a shoe calender. Van Haag discloses a shoe calender (Van Haag, Abstract, and Figures 1 and 2). It would be obvious to combine the teachings of Van Haag with Eriksson into the design of Eriksson, because such a combination would provide an additional means of calendaring the board prior to coating, and Eriksson discloses that such pre-calendering may be performed by any type of calender (Eriksson, pg. 5, lines 17-18).

Claims 18-20, 31-32: the shoes of Van Haag are divided into sectors in a travel direction where compression load is independently controllable (Abstract, col. 2, line 58 to col. 3, line 40, and Figures 1 and 2)

Claims 21-22: Van Haag does not disclose specific pressures applied, however it would have been inherent that even if no numerical numbers are specified, the reference can meet the zero value of the range claimed. Eriksson discloses pressure of 1,000 kPa (col. 6, line 20).

5) Claims 16-17, 23-26, 29-30, 33-34, are rejected under 35 U.S.C. 103(a) as being unpatentable over Eriksson in view of Van Haag, as applied to claim 14 above, and further in view of Koivukunnas (5,483,873).

Claims 16-17, 29-30, 33-34: Koivukunnas discloses a belt calender having a nip between two rolls (col. 5, lines 43-67, and Figure 3). It would have been obvious to combine the teachings of Koivukunnas with Eriksson in view of Van Haag, because such a combination would provide support and control of the web in the calendaring process of Eriksson.

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Claims 23-24: Koivukunnas discloses heating of the web in the calendering operation until the web reaches glass transition temperature (Abstract, col. 6, lines 1-39).

Claims 25-26: Koivukunnas discloses wetting of the web with aid from a heated backing roll (col. 6, lines 1-39).

Conclusion

6) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Aberg (WO 95/34715) discloses pressure forces in a calender nip; Hirvonen (5,938,895) discloses a calender system; Bubik (5,163,364) discloses a long nip calender.

7) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri. (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 703-308-3837. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

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Mark Halpern
Patent Examiner
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March 28, 2002

Handwritten signature